

REMARKS

Applicant has carefully reviewed the Office Action mailed February 28, 2003. Favorable reconsideration is respectfully requested in light of the above amendments and the following comments. Claims 1-10 are currently pending in the application, and all pending claims have been rejected. Claims 2-10 have been amended to correct their preambles. Claims 11-26 were previously withdrawn from consideration as the result of an election. No new matter has been added as a result of these amendments, which are presented herein in accordance with the revised format afforded by the proposed amendments to 37 CFR § 1.121.

Applicant respectfully traverses the Examiner's rejection of claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over Evard et al., U.S. Patent No. 4,981,478 (hereinafter Evard), in view of Carson, Jr., et al., U.S. Patent No. 5,116,317 (hereinafter Carson). The Examiner admits that Evard fails to describe that the selectively curable material of the first layer is at least partially cured at desired positions of the first layer, but asserts that Carson suggests the same. This is incorrect, as the Examiner has not provided a *prima facie* case of obviousness with respect to combining the references as suggested.

In order to provide a proper *prima facie* case of obviousness, it is necessary to show that (1) there is motivation to combine the references as suggested, and that the motivation comes from outside the claimed invention; (2) there is a reasonable expectation of success by one of skill in the art; and (3) that the asserted combination discloses each and every claimed limitation.

With respect to (1) motivation, Applicant notes once again that Evard teaches that catheter flexibility can be modified by adjusting the angle at which the strands are wrapped around the support member. Evard neither describes nor suggests using selectively curing of a selectively curable material (such as an epoxy, for example) in order to affect catheter flexibility.

Similarly, Carson fails to describe or suggest the use of selective curing to affect catheter flexibility. Instead, as noted by the Examiner, Carson appears to teach that ultraviolet-cured epoxy provides structural strength. Carson neither describes nor suggests selective curing of a selectively curable material in order to affect catheter flexibility. Indeed, Carson describes using a coating such as an epoxy for securing together a bundle of fiber optics cables.

The Examiner has suggested that it would be obvious to combine the references, as it would be desirable to increase the structural strength of the catheter. While improved structural

strength may be a desirable attribute, one cannot draw a simple corollary between improving structural strength and selectively curing a material to impart desired changes to catheter flexibility. Carson does not describe or suggest this feature of the claimed invention.

It would appear that the only reasonable motivation to combine Evard and Carson as suggested comes from the claimed invention itself. This is reconstructive hindsight and is impermissible. For at least this reason, the rejection is improper and should be withdrawn.

Moreover, as one of skill in the art would have no practical motivation to combine the references as suggested, there is no reason to expect that said person of skill would have any reasonable expectation that such a combination would result in success. Applicant does not concede that the cited combination meets all of the claimed limitations. Favorable reconsideration is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over Evard et al., U.S. Patent No. 4,981,478, in view of Lefebvre, U.S. Patent No. 5,810,874 (hereinafter Lefebvre). As discussed above, Evard fails to describe or suggest that the selectively curable material of the first layer is at least partially cured at desired positions of the first layer. Lefebvre is relied upon to remedy this noted shortcoming of Evard. Once again, the Examiner has not provided a *prima facie* case of obviousness with respect to combining the references as suggested.

As noted, one of the requirements of a proper *prima facie* case of obviousness is to demonstrate that there is a motivation to combine the references as suggested, and that said motivation is found in a source external to the pending application.

The Examiner notes that Lefebvre teaches using a cured epoxy to secure a sleeve to a catheter and asserts that it would be obvious to one of skill in the art to modify Evard in order to make sure that Evard's different layers are securely attached to each other. While it may be desirable to ensure that the different layers of a catheter are, in fact, secured together, a suggestion to glue portions of a catheter together is simply not equivalent to selectively curing a material to impart desired changes to catheter flexibility. Lefebvre is silent as to this aspect of the claimed invention.

Thus, it would appear that the only reasonable motivation to combine Evard and Lefebvre as suggested comes from the claimed invention itself. This is reconstructive hindsight and is impermissible. For at least this reason, the rejection is improper and should be withdrawn.

Moreover, as one of skill in the art would have no practical motivation to combine the references as suggested, there is no reason to expect that the person of skill would have any reasonable expectation that such a combination would result in success. Applicant does not concede that the cited combination meets all of the claimed limitations. Favorable reconsideration is respectfully requested.

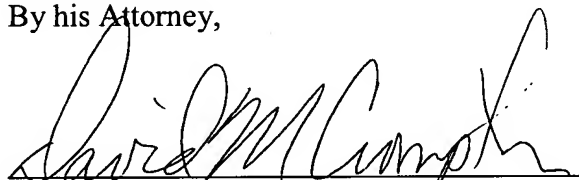
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims, namely claims 1-10, are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,

Date: 5/27/03



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